



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,404	07/29/2003	Noriyuki Suzuki	00862.023154	6374

5514 7590 12/18/2006  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

CHERY, MARDOCHEE

ART UNIT	PAPER NUMBER
----------	--------------

2188

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,404	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Mardochee Chery	<b>Art Unit</b> 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2006 has been entered.
2. In response to the Advisory action mailed on October 10, 2006, claims 1-7, 12 and 14 have been amended. Claim 13 has been canceled. No claims have been added. As a result, claims 1-12, 14 and 15 are now pending.
3. The objection to the specification and to claim 3 has been withdrawn due to the amendment filed on September 7, 2006.

***Response to Arguments***

4. Applicant's arguments filed September 7, 2006 have been fully considered but they are not persuasive.

a. Applicants argue on page 11, paragraph 3 of the remarks that nothing in Yamamoto is seen to disclose or suggest that "a judgment whether or not a storage unit is in an ejectable state is made by the storage unit itself. Moreover, Yamamoto is not seen to disclose or suggest that it is the storage unit that outputs an eject permission to an information processing apparatus, for ejecting the storage unit by ejecting means if it is judged that the storage unit is in the ejectable state".

Examiner respectfully disagrees and would like to point out that Yamamoto is not relied upon for teaching such features. Uchida, rather, is relied upon as shown in the Office action mailed June 7, 2006.

b. Applicants further argue on page 11, paragraph 4 of the remarks that Uchida is not seen to compensate for the deficiencies of Yamamoto.

Examiner respectfully disagrees. The claims simply recite "judging means for judging whether or not the storage is in an ejectable state; and outputting means for outputting an eject permission signal to the information processing apparatus for ejecting the storage unit by said

ejecting means if said judging means judges that the storage unit is in the ejectable state”.

Uchida clearly discloses the claimed features in at least Figs. 6-7, and by disclosing “outputting a disk ejection instruction if the registered password and disk ejection instruction are input; Abstract; in Fig. 6, in step 601, it is judged whether or not there is an ejection instruction thereby judging whether or not the disk is in an ejectable state; a disk ejection instruction is outputted if a disk ejection instruction is inputted (i.e., placing the the disk or storage unit in an ejectable state); ¶ [0010].

Uchida further discloses “outputting a disk ejection instruction to a mechanism control means if a disk ejection instruction and authentication information are input (i.e., placing the disk or storage unit in an ejectable state); ¶¶ [0008-0011].

Thus, it has been clearly shown that Uchida discloses the claimed feature of “judging means for judging whether or not the storage is in an ejectable state” and as such Applicant’s claimed invention is not patentably distinct over Yamamoto in view of Uchida.

- c. Therefore, the rejection of claims 1-12, 14 and 15 is strictly maintained and reproduce below with changes addressing the latest amendments to the claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (2002/0032839) in view of Uchida (2004/0037174).

As per claim 1, Yamamoto discloses a storage unit which is detachable from an information processing apparatus, and has a storage medium for storing data from the information processing apparatus [Figs .2, 15; paragraph 12, lines 1-3, paragraphs 13 and 17-18] comprising: having ejecting means for ejecting the storage unit [Fig.15; par. 17]; output means for externally outputting an eject permission signal in accordance with input of the eject instruction [par.11].

However, Yamamoto does not explicitly teach a controller for controlling storage of data into the storage medium; receiving means for receiving an eject instruction of ejecting the storage unit from the information apparatus; judging means for judging whether or not the storage unit is in an ejectable state; and output means for externally outputting an eject permission signal to the information processing apparatus for ejecting the storage unit by said ejecting means if said judging means judges that the storage unit is in the ejectable as recited in the claim.

Uchida discloses a controller for controlling storage of data into the storage medium [Fig. 1; controller 20]; receiving means for receiving an eject instruction of ejecting the storage unit from the information apparatus [Fig. 1; eject instruction section 34]; judging means for judging whether or not the storage unit is in an ejectable state [Fig. 6; Abstract; par. 10]; and output means for externally outputting an eject permission signal to the information apparatus for ejecting the storage unit by said ejecting means if said judging means judges that the storage unit is in the ejectable state [Fig. 6; Abstract; pars. 8-11] to provide a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented (par. 6).

Since the technology for implementing a storage unit with a controller, means for receiving an eject instruction, output means for outputting an eject permission signal was well known as evidenced by Uchida, an artisan would have been motivated to implement this feature in the system of Yamamoto to provide a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to modify the system Yamamoto to include a storage unit with a controller, means for receiving an eject instruction, output means for outputting an eject permission signal since this would have provided a disk drive device wherein removal of the disk drive by persons other than the authorized user can be positively prevented (par. 6) as taught by Uchida.

As per claim 2, Yamamoto discloses the unit further comprises state shift means for shifting the storage unit to the ejectable state when the eject instruction is received by said receiving means, [pars.18, 121-123, 128].

Uchida further discloses wherein said judging means judges that the storage unit is in the ejectable state after completion of the shift to the ejectable state by said shift means [Figs 1 and 6]; and output means for externally outputting an eject permission signal to the information apparatus for ejecting the storage unit by said ejecting means if said judging means judges that the storage unit is in the ejectable state [Fig. 6; Abstract; pars. 8-11].

As per claim 3, Yamamoto discloses the state shift means inhibits reception of an external input, and executes cash memory flush processing [par.18].

As per claim 4, Yamamoto discloses output means uses an extra signal line [par.128].

As per claim 5, Yamamoto discloses input means receiving means receives an eject command as the eject instruction [par.11].

As per claim 6, Yamamoto discloses receiving means receives a status of an operation switch as the eject instruction via an extra signal line [par.128].



As per claim 7, Yamamoto discloses the receiving means further comprises switch receiving means for receiving a status of an operation switch, and notification means for notifying the information processing apparatus of an operation status of the operation switch on the basis of the status of the operation switch that is received by said switch receiving means [pars.124 and 127].

As per claim 8, Yamamoto discloses receiving means can receive, as the eject instruction, an eject command issued by the information processing apparatus and a signal from an operation switch, and when the signal from the operation switch is received as an eject instruction, said state shift means shifts the storage unit to the ejectable state at the end of data communication between the information processing apparatus and the storage unit [pars.124 and 127].

As per claim 9, Yamamoto discloses the operation switch is arranged in the storage unit [Fig.17].

As per claim 10, Yamamoto discloses providing means for providing a user interface [par. 8]; issuing means for issuing eject instruction to the storage unit in accordance with user operation to the user interface [par.8]; and eject means for ejecting the storage unit on the basis of an eject permission signal which is output from the storage unit in accordance with the eject instruction [par. 11].

As per claim 11, Yamamoto discloses monitoring means for inquiring of the storage unit as to a status of an operation switch, and monitoring a status signal representing the status of the operation switch [pars. 124 and 127]; issuing means for issuing eject instruction to the storage unit in accordance with user operation to a user interface provided by software or the status signal [par. 127]; and eject means for ejecting the storage unit on the basis of an eject permission signal which is output from the storage unit in accordance with the eject instruction [par. 127].

As per claim 12, the rationale in the rejection of claim 1 is herein incorporated. Yamamoto further discloses an receiving step of receiving eject instruction to the storage unit in accordance with user operation to the user interface [par. 8]; and an eject step of causing the information processing apparatus to eject the storage unit on the basis of the eject permission signal [par.11].

Uchida further discloses an output step of causing the storage unit to output an eject permission signal to the information processing apparatus in accordance with the eject instruction after completion of shifting the storage unit to the ejectable state in the state shift step [Fig. 6].

As per claim 14, the rationale in the rejection of claim 1 is herein incorporated.

As per claim 15, Yamamoto discloses the apparatus further comprises an eject

Art Unit: 2188

designation switch, and said transmission means transmits the eject instruction to the storage unit in accordance with operation on said eject designation switch [pars. 124 and 127].

### ***Conclusion***

7. When responding to the office action, Applicant is advised to clearly point out the patentable novelty that he or she thinks the claims present in view of the state of the art disclosed by references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R. 1.111(c).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mardochee Chery whose telephone number is (571) 272-4246. The examiner can normally be reached on 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sough Hyung can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2188

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 8, 2006



Mardochee Chery  
Examiner  
AU2188

  
HYUNGSOO CH  
SUPERVISORY PATENT EXAMINER

12/11/06